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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,509	04/06/2000	Phil Wyatt	MCO-P-00-003	9084

29013 7590 05/07/2007

PATENTS+TMS, P.C.
2849 W. ARMITAGE AVE.
CHICAGO, IL 60647

EXAMINER	
PASS, NATALIE	

ART UNIT	PAPER NUMBER
3626	

MAIL DATE	DELIVERY MODE
05/07/2007	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/544,509
Filing Date: April 06, 2000
Appellant(s): WYATT, PHIL

Brian M. Mattson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 June 2006 appealing from the Office action mailed 4 April 2006

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

This application was previously appealed to the Board (Appeal No. 2004-1826).

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1. "Specialty care Network Announces Internet Strategy; New HealthGrades.com Site to Offer Provider and Health Plan Rating Information." Business wire, p1519. 06-1999
2. Appellant's admissions in the "Background of the Invention" section of the Specification. 04-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph.

Claims 1-20 are rejected under 35 U.S.C. 103(a).

These rejections are set forth in prior Office Action, Paper No 03222006 and reproduced hereinbelow. The rejections that appear below substantially repeat the rejections made in the previous Office Action (Paper Number 03222006). The text of those sections of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office action, Paper Number 03222006.

1. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Independent claims 1, 15 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- "wherein the medical condition of the query is matched to a second medical condition" as disclosed in claim 1 at lines 21-22;
- "wherein the third information relates to the second medical condition" at lines 30-31;
- "means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query" in claim 15 at lines 24-26.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 6 April 2000. Appellant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

(B) Claims 2-14, 15-20 incorporate the features of independent claims 1, and 15, through dependency, and are also rejected.

Appellant is required to cancel the new matter in the reply to this Office Action.

2. If Appellant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 6 April 2000.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

(A) Claim 1 recites "matched to a second medical condition from the plurality of medical resources in the first information" on lines 22-23. However the "first information" as defined in claim 1 relates to "a plurality of medical conditions," not a plurality of medical "resources." For the purpose of applying art, Examiner assumes the limitation to read "matched to a second medical condition from the plurality of medical conditions in the first information." Appropriate correction is required.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Business Wire article "Specialty care Network Announces Internet Strategy; New HealthGrades.com Site to Offer Provider and Health Plan Rating Information." June 30, 1999, Business wire, p1519,

hereinafter known as HealthGrades, in view of Appellant's admissions in the "Background of the Invention" section of the Specification, (hereinafter known as "AAPA").

(A) As per claim 1, HealthGrades teaches a method for matching medical condition information with a medical resource, the method comprising the steps of:

providing a computer network (such as the Internet) having a plurality of remote computers and at least one remote server wherein the remote server hosts a website (HealthGrades, paragraph 5);

accessing the website or "portal for consumers to locate a wealth of information on the leading hospitals, physicians and health plans" (reads on "via an individual remote computer on the computer network") (HealthGrades, paragraph 5);

providing a web site where "consumers find objective data regarding the best hospitals and physicians to treat their illness" (reads on "inputting a query or request for data into the website wherein the query relates to a first medical condition") (HealthGrades, paragraph 5);

storing first information relating to a plurality of medical conditions (HealthGrades; paragraph 5) and second information relating to a plurality of medical resources (HealthGrades; paragraph 5) wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which [treat] at least one of the plurality of medical conditions; Examiner interprets HealthGrades teachings of "only through HealthGrades.com or through one of its partner sites can consumers find objective data regarding the best hospitals and physicians to treat their illness" (HealthGrades; paragraph 5) as teaching storing of Appellant's "first information" and "second information;"

searching the first information and the second information based on the query input into the website (HealthGrades; paragraph 5) wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information wherein a medical resource from the plurality of medical resources in the second information is matched to the medical condition of the query (HealthGrades; paragraphs 4-5) wherein the medical condition of the query is treatable by the medical resource; Examiner interprets HealthGrades teachings of "[f]irst, they want to know about the disease and the appropriate procedure to treat the disease. Second, they want to know where and to whom to go to for the best care. Many sites provide information on the former" (HealthGrades; paragraph 4) and "Consumer sites such as AOL.com's Health & Fitness Channel (NYSE:AOL),drkoop.com (Nasdaq:KOOP), iVillage's BetterHealth.com (Nasdaq:IVIL),Yahoo!'s Health channel (Nasdaq:YHOO), MSN's Health channel (Nasdaq:MSFT),Onhealth (Nasdaq:ONHN), Mediconsult (Nasdaq:MDCS), Healtheon's WebMD(Nasdaq:HLTH), and adam.com (Nasdaq:ADAM) provide valuable disease and condition information to consumers" (HealthGrades; paragraph 5) as teaching inputting queries into a website wherein medical conditions in the query are matched to stored medical conditions in the "first information;" and Examiner interprets HealthGrades teachings of "only through HealthGrades.com or through one of its partner sites can consumers find objective data regarding the best hospitals and physicians to treat their illness" (emphasis added) (HealthGrades; paragraph 5) as teaching "wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources;" and

displaying third information via the individual remote computer wherein the third information relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query; Examiner interprets a "Web site" that is a "portal for consumers" (HealthGrades; paragraph 5) and a "Web-based site for the distribution of free health care provider ... [...] ... information" (paragraph 2) and that enables "consumers [to] find objective data regarding the best hospitals and physicians to treat their illness" (emphasis added) (HealthGrades; paragraph 5) as teaching this limitation.

Although HealthGrades teaches "applying complex and proprietary Company-developed algorithms to collected provider data" (HealthGrades, paragraph 3), HealthGrades fails to explicitly disclose

providing a database on the remote server wherein the database stores first information relating to a plurality of medical conditions and second information relating to a plurality of medical resources.

However, the above features are well-known in the art, as evidenced by Appellant's own disclosure.

In particular, Appellant's specification teaches "...generally known to provide information on a computer network ... [...] ... allow an individual to access a database...[that] ... may contain the information in an organized manner so that an individual on a remote computer may access the website and search the database for particular information" (AAPA, page 1, lines 21-30) and "it is generally known to provide access to databases that may contain medical information" (AAPA, page 2, lines 3-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of HealthGrades to include these limitations, as disclosed by Appellant's own specification, with the motivations of allowing "consumers [to] find objective data regarding the best hospitals and physicians to treat their illness," based on "collected provider data" (HealthGrades, paragraphs 3, 5).

(B) As per claims 2-8, HealthGrades and AAPA teach a method as analyzed and discussed in claim 1 above, further comprising the step of

providing a "portal for consumers to locate a wealth of information on the leading hospitals, physicians and health plans" (reads on "outputting the third information to the individual remote computer" (HealthGrades, paragraph 5); and

wherein the medical disorders or conditions relate to diseases (HealthGrades, paragraph 3);

further comprising the step of providing medical procedure information to one of the computers (HealthGrades, paragraph 3);

searching the database for medical procedure information (HealthGrades, paragraph 3);

disclosing on one of the remote computers a practitioner or provider that treats the medical condition of the query (HealthGrades, paragraphs 3, 5);

disclosing a medical facility to the individual remote computer wherein the medical facility treats the medical condition of the query (HealthGrades, paragraphs 3, 5); and

further comprising the step of disclosing medical resource information relating to the medical resource wherein the medical resource information includes "where and to whom to go

for the best care" and "about the appropriate procedure to treat the disease" (reads on "a name of the medical resource, a location, contact information and services offered") (HealthGrades, paragraph 3).

(C) As per claims 9-14, HealthGrades and AAPA teach a method as analyzed and discussed in claim 1 above,

further comprising the step of linking one of the remote computers to a specific website relating to the medical resource (HealthGrades, paragraphs 5-6);

wherein the third information discloses more than one resource from the plurality of medical resources that treat the medical condition of the query; Examiner interprets HealthGrades' teaching of providing a web site where "consumers find objective data regarding the best hospitals and physicians to treat their illness," (HealthGrades, paragraph 5), as reading on this limitation;

wherein the query includes disease information (reads on "identifying information of an individual using the website") (HealthGrades, paragraphs 3-6) wherein the third information disclosesone of the plurality of medical resources which matches the identifying information (HealthGrades, paragraphs 3-8);

disclosing a medical resource from the plurality of medical resources that treat the medical condition of the query; Examiner interprets HealthGrades' teaching of providing a web site where "consumers find objective data regarding the best hospitals and physicians to treat their illness," (HealthGrades, paragraph 5), as reading on this limitation; and

ranking the medical resources based on how the medical resources match the query; Examiner interprets HealthGrades' teaching of providing a web site that "rates virtually every U.S. hospital based on specific performance..." (HealthGrades, paragraph 4) as reading on this limitation;

providing a plurality of websites on the computer network (HealthGrades, paragraph 5);

accessing any one of the plurality of websites via the remote computer (HealthGrades, paragraph 5); and

searching the database via any one of the plurality of websites (HealthGrades, paragraphs 5-6);

providing a plurality of databases on a plurality of remote servers wherein the databases store the first information relating to the plurality of medical conditions (HealthGrades, paragraphs 5-8);

linking the databases via the computer network (HealthGrades, paragraphs 5-6); and

searching the databases for the third information (HealthGrades, paragraphs 5-8).

(D) Claims 15-20 differs from method claims 1-4, 6, and 9, in that they recite a system rather than a method for matching medical condition information with a medical resource.

As per the recitation in claim 15 of means for contacting the medical resource on the website wherein the medical resource is contactable from the website via the means for contacting the medical resource, HealthGrades and AAPA teach a system further comprising

means for contacting the medical resource on the website wherein the medical resource is contactable from the website via the means for contacting the medical resource (HealthGrades; paragraph 6); Examiner interprets HealthGrades teachings of "[t]he site will contain over 20 solution-based content areas, providing online and downloadable forms, templates, tools, communications resources (e-mail and message boards) and more" as teaching this limitation.

The remainder of system claims 15-20 repeat the subject matter of claims 1-4, 6, and 9, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 1-4, 6, and 9 have been shown to be fully disclosed by the teachings of HealthGrades and AAPA in the above rejection of claims 1-4, 6, and 9, it is readily apparent that the system disclosed by HealthGrades and AAPA includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1-4, 6, and 9, and incorporated herein.

The motivations for combining the respective teachings of HealthGrades and AAPA are as given in the rejection of claim 1 above, and incorporated herein.

(10) Response to Argument

In the Appeal Brief filed 13 June 2006, Appellant makes the following argument:

VII. ARGUMENT

A. THE REJECTION OF CLAIMS 1-20

UNDER 35 U.S.C §112, FIRST PARAGRAPH

B. CLAIMS 1-20 CONTAIN SUBJECT MATTER WHICH

WAS DESCRIBED IN THE SPECIFICATION IN SUCH A WAY AS TO REASONABLY CONVEY TO ONE SKILLED IN THE RELEVANT ART THAT THE INVENTOR, AT THE TIME THE APPLICATION WAS FILED, HAD POSSESSION OF THE CLAIMED INVENTION

C. THE REJECTION OF CLAIM 1 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

D. CLAIM 1 IS NOT INDEFINITE FOR FAILING TO PARTICULARLY POINT OUT AND DISTINCTLY CLAIM THE SUBJECT MATTER WHICH APPELLANT REGARDS AS THE INVENTION

E. THE CITED REFERENCES AND REJECTION OF C LAIMS 1-20 UNDER 35 U.S.C. 103(a)

F. CLAIMS 1-20 WOULD NOT HAVE BEEN OBVIOUS TO ONE OF ORDINARY SKILL IN THE ART AT THE TIME OF APPELLANT'S INVENTION OVER HEALTHGRADES IN VIEW OF AAPA

Examiner will address Appellant's arguments in sequence as they appear in the brief.

VII. ARGUMENT

A. THE REJECTION OF CLAIMS 1-20 UNDER 35 U.S.C §112, FIRST PARAGRAPH

There is no specific argument under this heading; the subject matter is discussed below.

B. CLAIMS 1-20 CONTAIN SUBJECT MATTER WHICH WAS DESCRIBED IN THE SPECIFICATION IN SUCH A WAY AS TO REASONABLY CONVEY TO ONE SKILLED IN THE RELEVANT ART THAT THE INVENTOR, AT THE TIME THE APPLICATION WAS FILED, HAD POSSESSION OF THE CLAIMED INVENTION

With regard to Appellant's argument in section B., pages 6-8 of the Appeal Brief, that the rejections Of claims 1-20 under 35 USC § 112, first paragraph, for introducing limitations that recite new matter are improper, and should be reversed, Examiner respectfully disagrees. Although Examiner was able to find support for inputting a query or request for data into a website, wherein the query relates to a medical condition and Examiner was able to find support for disclosing, in response to the query related to the medical condition, a medical resource, such as a doctor or a hospital, that treats the medical condition queried and Examiner was able to find support for disclosing a plurality of medical resources that treat the disorder queried within Appellant's application, as originally filed on 6 April 2000, the Examiner was unable able to find any support for the limitations, as currently recited in the amended claims, of "wherein the medical condition of the query is matched to a second medical condition" and "wherein the third information relates to the second medical condition" and "means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query" (emphasis added). As such, Examiner interprets the rejections under 35 USC § 112, first paragraph, for introducing new matter, to be proper, and to stand.

C. THE REJECTION OF CLAIM 1 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

There is no specific argument under this heading; the subject matter is discussed below.

D. CLAIM 1 IS NOT INDEFINITE FOR FAILING TO PARTICULARLY POINT OUT AND DISTINCTLY CLAIM THE SUBJECT MATTER WHICH APPELLANT REGARDS AS THE INVENTION

With regard to Appellant's argument in section D., pages 9-10 of the Appeal Brief, that the rejections of claim 1 under 35 USC § 112, second paragraph, for indefiniteness are improper, and should be reversed, Examiner respectfully disagrees. Examiner observes that in the "providing a database" step of claim 1, at lines 11-12, Appellant defines "first information" as "relating to a plurality of medical conditions" (emphasis added), and in the same step, at lines 11-12 Appellant defines "second information" as "relating to a plurality of medical resources" (emphasis added). However in the "searching" step, at lines 22-23, Claim 1 recites "matched to a second medical condition from the plurality of medical resources in the first information" (emphasis added). It is unclear how the first information, which is defined to relate to a plurality of medical "conditions," can contain a plurality of medical "resources," as required in the "searching" step. As such, Examiner interprets the rejections under 35 USC § 112, second paragraph, for containing indefinite language, to be proper, and to stand.

E. THE CITED REFERENCES AND REJECTION OF C LAIMS 1-20 UNDER 35 U.S.C. 103(a)

There is no specific argument under this heading; the subject matter is discussed below.

F. CLAIMS 1-20 WOULD NOT HAVE BEEN OBVIOUS TO ONE OF ORDINARY SKILL IN THE ART AT THE TIME OF APPELLANT'S INVENTION OVER HEALTHGRADES IN VIEW OF AAPA

With regard to Appellant's argument in section F., pages 12-22 of the Appeal Brief, that the rejections of claims 1-20 under 35 USC § 103(a), are erroneous, and should be reversed, Examiner respectfully disagrees.

At pages 12-22 of the Appeal Brief, Appellant argues that the limitations of claims 1-20 are not taught or suggested by the applied references. In response, all of the limitations which Appellant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of HealthGrades and AAPA, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Appeal Brief and in the prior Office Action (paper number 03222006), and incorporated herein. In particular, Examiner notes that "providing a database on the remote server wherein the database stores first information relating to a plurality of medical conditions and second information relating to a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical

resources are medical specialists, specialty hospitals, medical facilities and health facilities which at least one of the plurality of medical conditions" and "searching the first information and the second information in the database based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information" and "a medical resource from the plurality of medical resources in the second information is matched to the medical condition of the query wherein the medical condition of the query is treatable by the medical resource" as recited in claims 1 and 15, are taught by the cited references. In particular, Examiner notes that AAPA teaches databases that store information on medical diseases and that are located on remote servers (AAPA; page 1, line 21 to page 2, line 6); (Examiner interprets AAPA's teaching of "[i]t is, of course, generally known to provide information on a computer network. Generally, the computer network may consist of one or a plurality of remote servers that may host one or more websites that may allow an individual to access a database. The database may contain the information in an organized manner so that an individual on a remote computer may access the website and search [reads on "query"] the database for particular information ... [...] ... Further, it is also generally known to provide access to databases that may contain medical information such as, for example, diseases, disorders or medical procedures" (AAPA; page 1, line 21 to page 2, line 6) as reading on this limitation); and Examiner notes that HealthGrades teaches storing and querying remotely of information regarding medical resources, such as hospitals and physicians, that treat medical conditions, (HealthGrades; paragraph 5); (Examiner interprets HealthGrades teachings of "only through HealthGrades.com or through one of its partner sites can consumers find objective data regarding the best hospitals and physicians to treat their illness"

(emphasis added), (HealthGrades; paragraph 5), as teaching remote storing of a plurality of medical resource information and remote storing of a plurality of disease or "illness" information). In addition, Examiner interprets HealthGrades teachings of "[f]irst, they want to know about the disease and the appropriate procedure to treat the disease. Second, they want to know where and to whom to go to for the best care. Many sites provide information on the former" (HealthGrades; paragraph 4) and "Consumer sites such as AOL.com's Health & Fitness Channel (NYSE:AOL),drkoop.com (Nasdaq:KOOP), iVillage's BetterHealth.com (Nasdaq:IVIL), Yahoo!'s Health channel (Nasdaq:YHOO), MSN's Health channel (Nasdaq:MSFT), Onhealth (Nasdaq:ONHN), Mediconsult (Nasdaq:MDCS), Healtheon's WebMD(Nasdaq:HLTH), and adam.com (Nasdaq:ADAM) provide valuable disease and condition information to consumers" (HealthGrades; paragraph 5) as teaching inputting queries into a website wherein medical conditions in the query are matched to stored medical conditions in the "first information;" and Examiner interprets HealthGrades teachings of "only through HealthGrades.com or through one of its partner sites can consumers find objective data regarding the best hospitals and physicians to treat their illness" (emphasis added) (HealthGrades; paragraph 5) as teaching "searching ... based on the query input into the website .... wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources").

With respect to Appellant's argument at page 15 of the Appeal Brief, that the combined applied references fail to teach or suggest displaying third information via the individual remote computer wherein the third information relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical

condition of the query, Examiner respectfully disagrees and notes that Examiner interprets a "Web site" that is a "portal for consumers" (HealthGrades; paragraph 5) and a "Web-based site for the distribution of free health care provider ... [...] ... information" (paragraph 2) and that enables "consumers [to] find objective data regarding the best hospitals and physicians to treat their illness" (emphasis added) (HealthGrades; paragraph 5) as teaching this limitation. Examiner notes that a "portal" is "a website that aims to be an entry point to the World-Wide Web, typically offering a search engine and/or links to useful pages, and possibly news or other services. These services are usually provided for free in the hope that users will make the site their default home page or at least visit it often. Popular examples are Yahoo and MSN. Most portals on the Internet exist to generate advertising income for their owners, others may be focused on a specific group of users and may be part of an intranet or extranet. Some may just concentrate on one particular subject, say technology or medicine ..." (source: Free On-line Dictionary of Computing, URL: <http://foldoc.org/foldoc/foldoc.cgi?portal>).

With respect to Appellant's arguments at page 15, paragraphs 2-3, of the Appeal Brief, that the applied references fail to disclose recited limitations in claim 15, these limitations have been previously addressed in this Office Action.

With respect to Appellant's arguments at the paragraph bridging pages 15-16 of the Appeal Brief, that the combined applied references fail to teach or suggest means for contacting the medical resource on the website, Examiner notes that HealthGrades teaches "[t]he site will contain ... [...] ... online and downloadable forms, templates, tools, communications resources (e-mail and message boards) and more" (HealthGrades; paragraph 6); Examiner interprets the

website containing "e-mail and message boards" to teach a form of "means for contacting the medical resource on the website."

With respect to Appellant's arguments at the paragraph bridging pages 16-17 of the Appeal Brief, that the Examiner's interpretation of the HealthGrades reference "is incorrect in view of paragraph 5 of *Healthgrades,*" Examiner notes that it was not only paragraph 5, but also paragraph 4 that was applied to teach the "searching" step. Examiner notes that Appellant appears to rely upon only a small subset of Examiner's applied art. Further it is the entire combined applied reference(s), and not only the cited passages that must be considered when evaluating whether or not the applied references teach the cited limitations. Examiner notes that, contrary to Appellant's analysis of the HealthGrades reference on pages 16-17 of the Appeal Brief, the HealthGrades reference teaches not only "report card products for physicians and health plans" but also teaches "a Web site ... [that is] ...a portal for consumers to locate a wealth of information on the leading hospitals, physicians and health plans and to make better informed health care decisions ... [...] .... Consumer sites such as AOL.com's Health & Fitness Channel (NYSE:AOL),drkoop.com (Nasdaq:KOOP), iVillage's BetterHealth.com (Nasdaq:IVIL),Yahoo!'s Health channel (Nasdaq:YHOO), MSN's Health channel (Nasdaq:MSFT),Onhealth (Nasdaq:ONHN), Mediconsult (Nasdaq:MDCS), Healtheon's WebMD(Nasdaq:HLTH), and adam.com (Nasdaq:ADAM) provide valuable disease and condition information to consumers. However, only through HealthGrades.com or through one of its partner sites can consumers find objective data regarding the best hospitals and physicians to treat their illness" (HealthGrades; paragraph 5). Further, Examiner notes that a "portal" is "a website that aims to be an entry point to the World-Wide Web, typically offering a search engine

and/or links to useful pages, and possibly news or other services. These services are usually provided for free in the hope that users will make the site their default home page or at least visit it often. Popular examples are Yahoo and MSN. Most portals on the Internet exist to generate advertising income for their owners, others may be focused on a specific group of users and may be part of an intranet or extranet. Some may just concentrate on one particular subject, say technology or medicine ..." (source: Free On-line Dictionary of Computing, URL: <http://foldoc.org/foldoc/foldoc.cgi?portal>). As such, Examiner interprets the HealthGrade" reference to not teach "merely the Hospital Report cards" as asserted by Appellant in paragraph 1 on page 17.

With respect to Appellant's arguments at the paragraph bridging pages 17-18 of the Appeal Brief, that the AAPA reference, Appellant's specification, "provides absolutely no teachings, references or even inferences that what was known prior to filing this application could have possibly been combined or otherwise modified by any reference or teaching," Examiner respectfully disagrees and observes that AAPA teaches "...generally known to provide information on a computer network ... [...] ... allow an individual to access a database...[that] ... may contain the information in an organized manner so that an individual on a remote computer may access the website and search the database for particular information" (AAPA, page 1, lines 21-30) and AAPA also teaches "... it is also generally known to provide access to databases that may contain medical information ... An individual may access the information when the individual wishes to learn more about a particular disease, disorder, and/or medical procedure. This information may be useful if an individual has been diagnosed with the disease or disorder and/or must have a particular medical procedure performed. The information may inform the

individual about the particular medical condition. Moreover, it is also generally known to access information regarding a particular resource related to a subject in which an individual may have an interest. Specifically, an individual may wish to contact the resource and to retrieve the contact information from the computer network." (AAPA, page 2, lines 3-19). Examiner does not see these teachings as lacking relevance, but rather sees these teachings as explicitly reciting storage of medical information in searchable databases.

As per Appellant's argument at pages 18-19 of the Appeal Brief that the there is no motivation to combine the references and that *prima facie* obviousness has not been established, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki,* 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976).

Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Appellant's claimed invention. Note, for example, the motivations explicitly stated at lines 8-10 of page 10 above (i.e., " ... with the motivations of allowing "consumers [to] find objective data regarding the best

hospitals and physicians to treat their illness," based on "collected provider data"... (HealthGrades, paragraphs 3, 5)).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Appellant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti* et al 192 USPQ 278 (CCPA) that:

(i) obvious does not require absolute predictability;

(ii) non-preferred embodiments of prior art must also be considered; and

(iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In addition, Examiner notes that according to *In re Kahn,* a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000), *In re Kahn,* Slip Op. 04-1616, page 9 (Fed. Cir. Mar. 22, 2006).

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has

been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Appellant appears to view the applied references without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

With regard to Appellant's argument from paragraph 4 of page 19 to paragraph 1 of page 20 of the Appeal Brief, that the limitations of claims 3-6 are not taught by the applied references, these arguments have already been discussed in this Examiner's Answer.

With regard to Appellant's argument in the paragraph bridging pages 20-21 of the Appeal Brief, that the limitations of claim 8 are not taught by the applied references, Examiner respectfully disagrees, and notes that the HealthGrades reference teaches the step of disclosing specific medical resource information wherein the specific medical resource information includes "where and to whom to go to for the best care" and "about the appropriate procedure to treat the disease" (HealthGrades, paragraph 3); Examiner interprets these teachings to show a form of "a name of the medical resource, a location, contact information and services offered" as recited in claim 8.

With regard to Appellant's argument on pages 21-22 of the Appeal Brief, that the limitations of claims 11, 14, 18 and 19 are not taught by the applied references, Examiner respectfully disagrees. Examiner notes that the HealthGrades reference teaches wherein the

query includes disease information, and also teaches "e-mail and message boards" (HealthGrades, paragraphs 3-6); Examiner interprets these teachings to show a form of "identifying information of an individual using the website" as recited in claim 11. With regard to the remainder of Appellant's arguments that the limitations of claims 11, 14, 18 and 19 are not taught by the applied references, these arguments have already been discussed in this Examiner's Answer.

NOTE: Examiner notes that there remains an objection to claim 1 which has been neither addressed nor corrected by Appellant's Appeal Brief. Claim 1 was objected to because of the following informalities: Claim 1 recites "which at least one of the plurality of medical conditions" in lines 17-18. For the purpose of applying art, Examiner assumed this limitation to recite "which treat at least one of the plurality of medical conditions."

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

Conclusion

Appellant's arguments at pages 6-22 of the Appeal brief filed 13 June 2006 do not appear to persuasively require a withdrawal of the Examiner's grounds of rejection. As specified in the remarks and rebuttals given above, Appellant's arguments apparently fail to appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied upon by the

Examiner for motivation to combine such well-known elements of the prior art. As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Examiner's Answer as well as the previous Office Action (Paper Number 03222006), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Natalie Pass
Examiner
Art Unit 3626

NP
February 13, 2007

Conferees

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

JOSEPH THOMAS
Supervisory Patent Examiner
Tech Center 3600

VINCENT MILLIN
Supervisory Patent Examiner
Tech Center 3600

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PHIL WYATT

Appeal No. 2004-1826
Application No. 09/544,509

ON BRIEF

Before OWENS, RUGGIERO, and DIXON, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-20, which are all of the claims in the application.

THE INVENTION

The appellant claims a method and system for disclosing, in response to a query related to a medical condition, a medical resource, such as a doctor or a hospital, that treats the medical condition queried. Claim 1, which claims the method, is illustrative:

1. A method for matching medical condition information with a medical resource, the method comprising the steps of:

providing a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website;

accessing the website via an individual remote computer on the computer network;

inputting a query into the website wherein the query relates to a medical condition;

providing a database on the remote server wherein the database stores information relating to a plurality of medical conditions; and

searching the database for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried.

THE REFERENCES

Siegrist, Jr. et al. (Siegrist)	5,652,842	Jul. 29, 1997
Schlueter, Jr. et al. (Schlueter)	5,974,124	Oct. 26, 1999
Iliff	6,022,315	Feb. 8, 2000

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-11 and 13-20 over Iliff in view of Schlueter, and claim 12 over Iliff in view of Schlueter and Siegrist.

OPINION

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 1 and 15.

Claims 1 and 15 require a database search that discloses a medical resource that treats a medical condition.

Iliff discloses a medical diagnosis and treatment advice system that provides medical advice for approximately one hundred of the most commonly encountered problems in general practice and emergency medicine, and may provide information to the public on any number of other medical topics (col. 4, lines 25-30). If the system determines that a serious medical condition exists, it plays a message that advises the patient to seek immediate medical attention and ends the evaluation process (col. 36, lines 9-13).

Schlueter seeks "to gather, organize, and present data which is collected over a long period of time in a way that best facilitates accurate diagnosis and proper treatment of such medical conditions which require long-term profiling of medical readings" (col. 2, lines 13-17). "Once the information is present in the database, all the medical practitioner needs to do is access the information via a network, telephone, or Internet connection and software capable of presenting processed data in a format that facilitates diagnosis, such as a graph or a chart" (col. 3, lines 13-17).[1]

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[1] Siegrist, which is applied to a dependent claim, discloses a computer-based method for comparing a service provider, such as a hospital, to its peers in several areas of competition for a particular consumer group (col. 1, lines 46-52; col. 2, lines 40-44).

The examiner argues that Iliff discloses "searching the database for the information wherein the search or request is based on the query or search request input into the database and further wherein the search discloses a medical resource that treats the medical condition queried (Iliff, Figure 31, Items 2510 and 2546, column 36, lines 9-13, column 60, lines 57-63, column 75, lines 18-28)" (answer, pages 4-5). Those portions of Iliff teach that the system provides medical advice which can be recommended tests or a recommendation that the patient seek immediate medical attention, but do not teach that the system discloses a medical resource that treats a medical condition.

The examiner argues that "[t]he access and retrieval of information from the database on request, as recited by Iliff, reads on searching the database for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried" (answer, page 13). This argument is not well taken because the advice retrieved from Iliff's database does not treat a medical condition.

To establish a *prima facie* case of obviousness of the claimed invention the examiner needs prior art that discloses, or would have fairly suggested, to one of ordinary skill in the art,

a system that discloses, in response to a query related to a medical condition, a medical resource, such as a doctor or a hospital, that treats the medical condition queried, and the examiner has not provided such prior art.

For the above reasons we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the appellant's claimed invention.

DECISION

The rejections under 35 U.S.C. § 103 of claims 1-11 and 13-20 over Iliff in view of Schlueter, and claim 12 over Iliff in view of Schlueter and Siegrist, are reversed.

REVERSED

Terry J. Owens)
Administrative Patent Judge)
)
Joseph F. Ruggiero)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS AND
Joseph L. Dixon) INTERFERENCES
Administrative Patent Judge)

JTO/eld

Appeal No. 2004-1826
Application No. 09/544,509

Patent + TMS
A Professional Corporation
1914 North Milwaukee Avenue
Chicago, IL 60647